

REMARKS

This response is a full and complete response to the non-final Office Action dated August 31, 2006. In the present Office Action, claims 1-19 and 21-69 are pending in the application, claims 9-19, 21-69 stand rejected, and claims 1-8 have been allowed. Claim 20 was previously cancelled.

By this response, claims 37-44 have been amended to conform to a common Beauregard format. No new matter has been added.

In view of the amendments above and the following remarks, it is submitted that the claims pending in the application are nonobvious. It is believed that this application is in condition for allowance. By this response, reconsideration and allowance of the remainder of the present application is respectfully requested.

ALLOWABLE SUBJECT MATTER

Claims 1-8 have been allowed. Assignee's representative thanks the Examiner for identifying allowable subject matter.

It should be noted that, while the Office Action Summary includes claims 1-8 in a rejected classification, there are no rejections of those claims in the entire Office Action. Therefore it is believed that the classification of these claims on the Office Action Summary is in error.

CLAIM REJECTIONS - 35 USC § 112

Claims 54-56 stand rejected under 35 USC § 112, first paragraph, as failing to comply the enablement requirement. Claim 54 is an independent claim and claims 55-56 are dependent thereon. This rejection is respectfully traversed.

For the rejection of claim 54, it is stated that it "recites a limitation that reads 'disable the antenna to enable a communication mode'". Contrary to the stated position in the Office Action the language in question in claim 54 actually reads as follows:

wherein the switch is adapted to selectively disable the antenna to provide, respectively, a wireless communication enabled mode having both the wireless communication and the local processing accessible, and a wireless communication disabled mode having the local processing accessible and the wireless communication inaccessible.
[Emphasis supplied]

As seen from the portion of the claim above, the disabling is performed by the switch **selectively** to provide one of two modes, namely, a wireless communication **enabled** mode and a wireless communication **disabled** mode. Therefore, the claim language is enabling and agrees with the teachings in the specification and drawings.

In view of the remarks above, it is submitted that claims 54-56 are allowable under 35 USC § 112.

CITED ART

U.S. Patent 6233464 to Chmaytelli ("Chmaytelli"), U.S. Patent 5,519,763 to Namekawa et al. ("Namekawa"), and JP 411017829 A to Matsuo ("Matsuo") are all cited and applied in the present Office Action.

CLAIMS REJECTIONS UNDER 35 USC § 103

Claims 9-19, 21 and 22

Claims 9-19, 21, and 22 under 35 U.S.C. 103(a) stand rejected as being unpatentable over Chmaytelli in view of Namekawa. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. (See MPEP § 2142.). Motivations to combine or modify references must come from the references themselves or be within the body of knowledge in the art. (See MPEP § 2143.01.)

Chmaytelli appears to teach multiple modes of operation in which there is no mode described expressly or impliedly in which the telephone is switched off. All modes described by Chmaytelli appear to teach turning the phone on. Chmaytelli only teaches turning the PDA off while leaving the phone in an on state. Chmaytelli fails to teach disabling the wireless communication functionality while enabling the local functionality as stated in claim 9. This is even admitted in the present Office Action at page 7, ¶3 with respect to a similar limitation in claim 23. Namekawa does nothing to cure this deficiency in the teachings of the combined references.

As noted by the Examiner, Namekawa was added to the present combination because "Chmaytelli fails to teach switching between the first and second modes of operation in response to a signal broadcast in a particular region." Namekawa appears to teach a system in which the devices are switched between one of two modes, namely, a telephone communication mode and a facsimile communication mode. That is, Namekawa's devices operate either as a facsimile or as a standard telephone for voice calls. Namekawa's disclosed method of operation is mutually exclusive in that only one mode operates while the other mode is inoperative. As disclosed by Namekawa, there is no voice telephone operation when the facsimile mode operates and there is no facsimile operation when the voice telephone operates. When combined with Chmaytelli in the manner suggested by the Examiner, these references still fail to teach the method of claim 9 in which one mode of operation has both wireless functionality and local functionality enabled.

There is no motivation in the references, despite the Examiner's assertions to the contrary, to have Chmaytelli employ broadcast signals that are used for switching between modes of operation. Moreover, there is no motivation for Namekawa to provide a mode of operation in which both the wireless communication functionality and the local functionality are enabled. Finally, there is no motivation to have Chmaytelli disable wireless communications while enabling local functionality.

In light of all the significant differences between claim 9 and the references applied thereto, it is submitted that claim 9 would not have been obvious to a person skilled in the art upon a reading of Chmaytelli and Namekawa, either separately or in

combination. Therefore, it is believed that claim 9 is allowable under 35 U.S.C. §103. Since claims 10-16 depend either directly or indirectly from independent claim 9, it is further believed that claims 10-16 are also allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 9-16 be withdrawn.

Claims 17-19, 21, and 22 are apparatus claims that include limitations on the modes of operation similar to those discussed above in claims 9-16. In addition, independent claim 17 and the claims dependent therefrom call for "a selection means triggered by an external entity". Chmaytelli fails to teach either such a means or the need for such a means and Namekawa fails to provide selection between modes of operation in which one mode has both local functionality and wireless communication functionality enabled.

Accordingly, it is believed that the combined references of Chmaytelli and Namekawa fail to teach, show, or suggest the particular elements defined in claims 17-19, 21, and 22. As a result, it is submitted that claims 17-19, 21, and 22 would not have been obvious to a person of ordinary skill in the art upon a reading of Chmaytelli and Namekawa, separately or in combination. Therefore, it is submitted that claims 17-19, 21, and 22 are allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 12-19, 21, and 22 be withdrawn.

CLAIMS REJECTIONS 35 USC § 103

Claims 23-69

Claims 23-69 under 35 U.S.C. 103(a) stand rejected as being unpatentable over Chmaytelli in view of Matsuo. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. (See MPEP § 2142). Motivations to combine or modify

references must come from the references themselves or be within the body of knowledge in the art. (See, MPEP § 2143.01.)

Chmaytelli has been described above. Matsuo is cumulative over the Namekawa reference described above.

Matsuo appears to teach a computer-based system in which two modes of operation are discriminated. One mode of operation supports a voice telephone call without any facsimile operability, while the other mode supports a facsimile call without any voice telephone capability. There is no mode in Matsuo in which both telephone and facsimile operate at the same time. Instead, Matsuo appears to teach that only one type of functionality can operate at a time, mutually exclusive of the other type of functionality. Moreover, Matsuo fails to show any mode of operation involving wireless signals. Thus, when Matsuo is combined with Chmaytelli, the combined references fail to teach, show, or suggest a method of claim 23 which calls for,

“enabling access to user-operated computing functionality and access to sending and receiving wireless signals; and subsequently disabling the access to sending wireless signals; while simultaneously maintaining the access to the user-operated computing functionality and the access to receiving wireless signals.”

There is no motivation in the references, despite the Examiner's assertions to the contrary, to have Chmaytelli disable wireless communications while enabling local functionality. Moreover, there is no motivation for Namekawa to provide a mode of operation in which both the wireless communication functionality and the local functionality are enabled.

In light of all the significant differences between claim 23 and the references applied thereto, it is submitted that claim 23 would not have been obvious to a person skilled in the art upon a reading of Chmaytelli and Matsuo, either separately or in combination. Therefore, it is believed that claim 23 is allowable under 35 U.S.C. §103. Since claims 24-36 depend either directly or indirectly from independent claim 23, it is further believed that claims 24-36 are also allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 23-36 be withdrawn.

Claims 37-44 include limitations on the modes of operation similar to those discussed above for claims 23-26. In addition, independent claim 37 and the claims dependent therefrom call for “subsequently disabling the access to sending wireless signals; and continuing enabling the access to the user-operated computing functionality” None of the references even remotely suggest that a part of the wireless communication functionality be disabled. In fact, Matsuo fails to incorporate any wireless communication functionality.

Accordingly, it is believed that the combined references of Chmaytelli and Matsuo fail to teach, show, or suggest the particular elements defined in claims 37-44. As a result, it is submitted that claims 37-44 would not have been obvious to a person of ordinary skill in the art upon a reading of Chmaytelli and Matsuo, separately or in combination. Therefore, it is submitted that claims 37-44 are allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 37-44 be withdrawn.

Claims 45-53 are apparatus claims that include limitations on the modes of operation similar to those discussed above for claims 37-44. As noted above, none of the references even remotely suggest that a part of the wireless communication functionality be disabled. Clearly, Matsuo fails to incorporate any wireless communication functionality at all. Thus, it is believed that the combined references of Chmaytelli and Matsuo fail to teach, show, or suggest the particular elements defined in claims 45-53. As a result, it is submitted that claims 45-53 would not have been obvious to a person of ordinary skill in the art upon a reading of Chmaytelli and Matsuo, separately or in combination. Therefore, it is submitted that claims 45-53 are allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 45-53 be withdrawn.

Claims 54-56 are apparatus claims that include limitations on the modes of operation similar to those discussed above for claim 23. The present Office Action fails to expressly show how the references are to be applied to these claims. In spite of this, it is noted that none of the references even remotely suggest a wireless communication enabled mode and a wireless communication disabled mode as described in claim 54. Matsuo even fails to incorporate any wireless communication functionality at all. In addition, no reference shows that a switch is “adapted to selectively disable the antenna

to provide” the wireless communication enabled mode and the wireless communication disabled mode. Thus, it is believed that the combined references of Chmaytelli and Matsuo fail to teach, show, or suggest the particular elements defined in claims 54-56. As a result, it is submitted that claims 54-56 would not have been obvious to a person of ordinary skill in the art upon a reading of Chmaytelli and Matsuo, separately or in combination. Therefore, it is submitted that claims 54-56 are allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 54-56 be withdrawn.

Claims 57-64 include limitations on the modes of operation similar to those discussed above for claim 23. None of the references even remotely suggest anything related to disabling wireless signal communication while simultaneously maintaining access to the interactive data processing functionality. Matsuo does not suggest the use of any wireless communication functionality at all. Thus, it is believed that the combined references of Chmaytelli and Matsuo fail to teach, show, or suggest the particular elements defined in claims 57-64. As a result, it is submitted that claims 57-64 would not have been obvious to a person of ordinary skill in the art upon a reading of Chmaytelli and Matsuo, separately or in combination. Therefore, it is submitted that claims 57-64 are allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 57-64 be withdrawn.

Claims 65-69 include limitations on the modes of operation similar to those discussed above for claims 9 and 23. None of the references even remotely suggest switching from one mode wherein both the wireless communications and computing functionalities are operational to another mode wherein the wireless communications functionality is not operational and the computing functionality is operational. Matsuo does not suggest the use of any wireless communication functionality at all. Thus, it is believed that the combined references of Chmaytelli and Matsuo fail to teach, show, or suggest the particular elements defined in claims 65-69. As a result, it is submitted that claims 65-69 would not have been obvious to a person of ordinary skill in the art upon a reading of Chmaytelli and Matsuo, separately or in combination. Therefore, it is submitted that claims 65-69 are allowable under 35 U.S.C. §103. It is respectfully requested that the rejection of claims 65-69 be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all the claims pending in this patent application are in condition for allowance. Reconsideration and allowance of all the claims are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Gregory C. Ranieri, Esq. at (503) 439-6500 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: Tuesday, January 02, 2007

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